



A DOCPHOENIX

Office Action Summary

Application No.

09/559,402

Applicant(s)

SOUTHERN ET AL.

Examiner

Bradley L. Sisson

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1655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 18) ☒ Interview Summary (PTO-413) Paper No(s) 9.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. Acknowledgement is made of a request for clarification by the Office as to whether reference AO had been considered. Reference AO has not been considered as it was not found in the file.

Specification

2. A substitute specification not including the claims is required pursuant to 37 CFR 1.125(a) because the specification is found to be replete with idioms such as “analogues,” “synthesise,” “favour,” and “hybridisation.”

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and must be accompanied by: 1) a statement that the substitute specification contains no new matter; and 2) a marked-up copy showing the amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.

Claim Objections

3. A series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

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A claim which depends from a dependent claim should not be separated by any claim which does not also depend from said dependent claim. To that end it is noted that claims 20, 22, 24, 26, and 28, which all depend from claim 14, are separated from said claim 14 by independent claim 15. In general, applicant's sequence will not be changed. See MPEP § 608.01(n).

Acknowledgement is made of applicant's request to hold correction of claim numbering until allowable subject matter has been identified.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 14-41 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the subject matter set forth in claims 1-13 issued in parent application, now US Patent 6,080,585, does not reasonably provide enablement for the study of the tertiary structure of any molecule of known sequence. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

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Factors to be considered in determining whether a disclosure would require undue experimentation have been summarized in *In re Wands*, 8 USPQ2d 1400 (CAFC 1988). They include (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims.

The Quantity of Experimentation Necessary

The quantity of experimentation is immense, requiring many man-years of labor with little if any reasonable expectation of success.

The Amount of Direction or Guidance Provided

The amount of guidance provided is very limited, with only prophetic statements of broader application.

The Presence or Absence of Working Examples

The specification does not provide any example where a non-nucleic acid polymer was used and where the ligand was something other than an oligonucleotide. The specification does not set forth the reaction conditions, or a range of reaction conditions under which a variety of analyte ligand interactions can be evaluated. The situation at hand is analogous to that in *Genentech v.*

Novo Nordisk A/S 42 USPQ2d 1001. As set forth in the decision of the Court:

“ ‘[T]o be enabling, the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without undue experimentation.’ *In re Wright* 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993); *see also Amgen Inc. v. Chugai Pharms. Co.*, 927 F. 2d 1200,

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1212, 18 USPQ2d 1016, 1026 (Fed Cir. 1991); *In re Fisher*, 427 F. 2d 833, 166 USPQ 18, 24 (CCPA 1970) ('[T]he scope of the claims must bear a reasonable correlation to the scope of enablement provided by the specification to persons of ordinary skill in the art.').

"Patent protection is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable. *See Brenner v. Manson*, 383 U.S. 519, 536, 148 USPQ 689, 696 (1966) (starting, in context of the utility requirement, that 'a patent is not a hunting license. It is not a reward for the search, but compensation for its successful conclusion.'). Tossing out the mere germ of an idea does not constitute enabling disclosure. While every aspect of a generic claim certainly need not have been carried out by an inventor, or exemplified in the specification, reasonable detail must be provided in order to enable members of the public to understand and carry out the invention.

"It is true . . . that a specification need not disclose what is well known in the art. *See, e.g., Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1385, 231 USPQ 81, 94 (Fed. Cir. 1986). However, that general, oft-repeated statement is merely a rule of supplementation, not a substitute for a basic enabling disclosure. It means that the omission of minor details does not cause a specification to fail to meet the enablement requirement. However, when there is no disclosure of any specific starting material or any of the conditions under which a process can be carried out, undue experimentation is required; there is a failure to meet the enablement requirement that cannot be rectified by asserting that all the disclosure related to the process is within the skill of the art. It is the specification, not the knowledge of one skill in the art, that must supply the novel aspects of an invention in order to constitute adequate enablement. This specification provides only a starting point, a direction for further research.

In view of the limited guidance, it appears that applicant is seeking to impermissibly shift the burden from that of applicant to that of the public. As shown above, when the starting materials and reaction conditions are not disclosed, it would require undue experimentation to practice the full scope of the invention. Further, the claimed invention relates directly to matters of physiology and chemistry, which are inherently unpredictable and as such, require greater levels of enablement. As noted in *In re Fisher* 166 USPQ 18 (CCPA, 1970):

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In cases involving predictable factors, such as that, once imagined, other embodiments can be made without difficulty and their performance characteristics predicted by resort to known scientific laws. In cases involving unpredictable factors, such as most chemical reactions and physiological activity, the scope of enablement obviously varies inversely with the degree of unpredictability of the factors involved.

The Nature of the Invention

The invention relates directly to matters of chemistry and physiology. Areas of the art that are recognized as being unpredictable and deserving of greater levels of disclosure

The State of the Prior Art

The aspect of studying the tertiary structure of any type of polymer is undeveloped.

The Relative Skill of Those in the Art

The relative skill in the art is high, on par with those that hold a Ph.D. in biochemistry or physical chemistry.

The Breadth of Scope of the Claims

The claims have sufficient breadth of scope so to encompass the study of virtually any polymeric material, be it actual (natural or synthetic) or *en silico*. Similarly, the ligand can be virtually any molecule that will bind, either directly or indirectly, the analyte/polymeric material.

In view of the above showing, the specification has not been found to enable claims beyond that which have already been issued in US Patent 6,080,585 and the level of experimentation that a

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skilled artisan would have to resort to in order to resolve such issues constitutes undue experimentation.

Response to arguments

At page 5 of the response of 02 May 2001 it is asserted that the claimed invention would not require “undue [experimentation] since the invention is not complex or difficult to practice.”

It is first noted that the arguments presented are of applicant’s representative and are void of any factual underpinning. Further, the claimed subject matter relates directly to matters of chemistry which, as stated in the decision of *Fisher*, are considered to be unpredictable and deserving of greater levels of disclosure. The claimed invention relates directly to matters of physiology and chemistry, which are inherently unpredictable and as such, require greater levels of enablement.

In cases involving predictable factors, such as that, once imagined, other embodiments can be made without difficulty and their performance characteristics predicted by resort to known scientific laws. In cases involving unpredictable factors, such as most chemical reactions and physiological activity, the scope of enablement obviously varies inversely with the degree of unpredictability of the factors involved.¹

Attention is again directed to the decision in *Genentech* where it was held that the specification must provide both starting materials and reaction conditions. In the absence of either or both of these elements, the public is forced to resort to undue experimentation to practice the invention. As noted in the prior Office action and as reproduced above, the specification does not provide the requisite guidance.

¹ *In re Fisher* 166 USPQ 18 (CCPA, 1970).

Double Patenting

5. The double patenting rejection has been withdrawn as the terminal disclaimer received on 02 May 2001 has been found to be proper and has been recorded.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

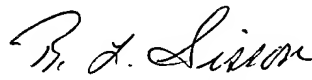
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley L. Sisson whose telephone number is (703) 308-3978. The examiner can normally be reached on 6:30 a.m. to 5 p.m., Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephanie Zitomer can be reached on (703) 308-3985. The fax phone numbers for

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the organization where this application or proceeding is assigned are (703) 305-3592 for regular communications and (703) 308-0294 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



Bradley L. Sisson
Primary Examiner
Art Unit 1655

BLS
May 24, 2001